

NEW POINT RAISED IN THE EXAMINER'S ANSWER

Claims 1-9, 17-22, 26-40 stand rejected under 35 U.S.C. § 112, First Paragraph and Claims 1, 4-10, 13-18, and 21-29 stand rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 5,679,117 (“*Jarvis*”). The present Reply will discuss the Examiner’s new arguments with respect to the rejection of Claims 5-6 and 14 as being anticipated by *Jarvis* based on inherency. The Appellants respond to this new point in the following.

APPELLANTS’ REPLY

The Examiner’s Answer states “Appellant argues that claims 5-6 and 13 are not anticipated by *Jarvis* because the examiner has not argued that the rejection of the claims is based on inherency. The examiner respectfully disagrees. In the Final Office action, p. 5, the examiner states ‘*Jarvis* teaches the same composition as set forth in the present invention. Therefore, *Jarvis* would inherently meet the limitations of reducing toxic air pollutants emissions.’” (Examiner’s Answer, p. 8).

To anticipate a claim, a reference must disclose every limitation of the claimed invention either explicitly or inherently. *In re Schreiber*, 44 U.S.P.Q.2d 1429, 1431 (Fed. Cir. 1997). The purpose of inherency is to accommodate those situations where the reference omits information that is within the common knowledge of technologists. *See Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991). The Examiner must show “a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int. 1990).

Respectfully, the Examiner has not shown a basis in fact or a technical reasoning to support the alleged inherent limitation of reducing toxic air pollutant emissions. As stated in the

Appeal Brief, *Jarvis* discloses a reaction product, not a blend, of gasoline and an oxygenate. *Jarvis* fails to disclose a *blend* of gasoline and oxygenate. The points noted in the Declaration of Charles A. Lieder, Ph.D., under 37 C.F.R. § 1.132, submitted with Response to Office Action of February 10, 2003, filed on April 9, 2003, established that *Jarvis* was directed to a chemical reaction and not a blend. *Jarvis* does not disclose or teach that blends will inherently reduce toxic air pollutants as required by these claims. *Jarvis*'s disclosure provides no basis for an inherency of an element of a blend. Accordingly, Claims 5-6 and 14 are not inherently anticipated by *Jarvis*.

CONCLUSION

In light of Appellants' Appeal Brief and this Reply, the rejection of Claims 1-9, 17-22, 26-40 under 35 U.S.C. § 112, First Paragraph and Claims 1, 4-10, 13-18, and 21-29 under 35 U.S.C. § 102(b) over *Jarvis* should be reversed.

Respectfully submitted,

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